

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Otake et al.		
Serial No.:	10/589,693	Case No.:	BY0036P
Filed:	August 17, 2006		Art Unit: --1614
For:	NOVEL SULFONAMIDE DERIVATIVES		Examiner: Mark L. Berch

Office of Petitions
Honorable Commissioner of Patents
Alexandria, VA 22313-1450

PETITION PURSUANT TO 37 C.F.R. § 1.181 AND
APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705

Sir:

This Petition is filed pursuant to 37 C.F.R. § 1.705 seeking reconsideration of the period of patent term adjustment awarded by the Patent Office in the captioned patent application.

STATEMENT OF FACTS

- 1) The captioned patent application is a US non-provisional application filed on August 17, 2006. The 371(c) date of this non-provisional patent application is August 17, 2006. The 371(b) date for this patent application is August 19, 2006, which is 30 months from the February 19, 2004 priority date of the Japanese provisional application. Applicants did not expressly request to begin examination before the 30 month date, therefore PTA is calculated from August 19, 2006.
- 2) The Patent Office issued a Restriction Requirement on May 21, 2009, 1006 days after the 30 month date. The 14-month cut off for purposes of calculating delay under 37 CFR 1.703(a)(1) is October 19, 2007. The PTO calculation of delay, under 37 CFR 1.703 (a)(1), 580 days, was correct.

- 3) A response to the Restriction Requirement dated May 21, 2009 was filed on June 8, 2009 via e-filing.
- 4) Applicants submitted an Information Disclosure Statement on September 14, 2006, via U.S. Express Mail. The IDS and references were indicated as received in the Patent Office on September 18, 2006.
- 5) A Notice of Allowance was mailed by the Patent Office on September 24, 2009. The Issue Fee is due on December 24, 2009.
- 6) This patent is not subject to a Terminal Disclaimer.
- 7) There were no instances in which Applicants failed to respond to an Official Action within the prescribed time frame. Consequently, a fee set forth in 37 C.F.R. § 1.18(f) and a showing of the of "all due care" under 37 C.F.R. § 1.705(c)(2) are not required.
- 8) This application for patent term adjustment is filed with an authorization to charge the petition fee, payment of the issue fee and any other fees due in connection with the captioned patent application to the Merck deposit account.

ARGUMENTS IN SUPPORT OF PETITION

The Patent Office has not provided any indication of patent term adjustment for delay beyond the date that is three years after filing date, i.e., no determination has been made taking into account delay under 37 C.F.R. § 1.703(b).

Under *Wyeth v. Dudas*, No. 07-1492 (D.D.C. 2008), a patentee is entitled to both any "(a) period" delay and any "(b) period" delay. According to *Wyeth*, 35 U.S.C. § 154 establishes that a patent term is 20 years from the earliest relevant filing date of a patent application. Because patentees do not benefit from the patent term during prosecution, § 154(b)(1) further provides a patent term adjustment (PTA) to account for delays by the Patent Office under certain circumstances. For example, the statute provides a one-day extension of term for every day corresponding to an "(a) delay," that is, where the Patent Office fails to meet particular deadlines such as issuing a first Office Action within 14 months, responding to a reply within four months, and so forth. In addition, the statute addresses a "(b) type delay" by giving a one-day extension of the patent term for every day of prosecution that occurs three years after the filing date.

To prevent double-counting, 35 U.S.C. § 154 dictates that, *to the extent that "(a) delays" and a "(b) delay" overlap, the patent term adjustment "shall not exceed the actual number of days the issuance of the patent was delayed."* § 154(b)(2)(A). (emphasis added). The Patent Office has interpreted this language to mean that a patentee may obtain credit for "(a) delays" or a "(b) delay," whichever is larger, but not (a) + (b). According to the Patent Office prior to *Wyeth*, any period of "(b) delay" necessarily overlapped with any periods of "(a) delays." The District Court found against the Patent Office in *Wyeth* and held that only actually overlapping days should be subtracted.

Since the three year date for this application occurred on August 19, 2009, and since there were no type (a) delays by the Patent Office after this date, the (b) period can be calculated as a day-for-day extension from August 19, 2009, until the date that the patent issues, less any time that the Patent Office deems Applicants to have been non-diligent in advancing prosecution.

CONCLUSION

Applicants urge that the correct Patent Term Adjustment is 580 days plus the full period of time calculated from the date that is the three years after the filing date, i.e., August 19, 2009, until the patent is granted, less any actual days of overlap (zero days) plus any additional time that is incurred by

the Patent Office in granting the patent, calculated from the date that is four months after the payment of the issue fee.

Enclosed herewith is an authorization to charge deposit account 13-2755 the \$200.00 fee required under § 1.18(e).

Respectfully submitted,

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